

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Group Art Unit: 1626

JEAN LAFAY et al Examiner: R. Havlin

Serial No.: 10/582,778

Filed: August 17, 2006

For: 1-N-PHENYL-AMINO-1H-IMIDAZOLE DERIVATIVES AND
PHARMACEUTICAL COMPOSITIONS CONTAINING THEM

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed April 1, 2009, Applicants elect the product of formula (I) where Z is Group I, with traverse, for prosecution in this application.

Unity of invention has already been reviewed by the International Preliminary Examination Authority, during the international preliminary examination. No finding of lack of unity was made during the international stage. It is therefore apparent that the International Preliminary Examination Authority has already determined that the criteria of PCT Rule 13 are satisfied in this application.

According to Article 27, paragraph 1, of the Patent Cooperation Treaty, it is not permissible for a National Office to require compliance with requirements which are different from or in addition to those of the Patent

Cooperation Treaty and implementing rules.

In view of this, it is not proper to raise an objection of lack of unity of invention during the US phase of the present PCT application.

In addition, it is the position of Applicants that the "unity of invention" criterion has been applied improperly.

Rule 13.1 stipulates that an International Application shall relate to an invention or a plurality of inventions so linked as to form a single general inventive concept. Rule 13.2 explains what is intended under the words of "single general inventive concept."

Rule 13.2 emphasizes that there is such a link when there exists between the inventions a technical relationship among those inventions involving one or more of the same or corresponding special technical features, those "special technical features" providing a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The assertion of lack of unity is based on an allegation that the common feature linking the claims is not a contribution over the prior art, the Restriction Requirement alleging that US 6,737,433 teaches overlapping compounds or obvious variations thereof.

Applicants do not agree with this allegation; the only possible overlap is in the case of Group I, where Z is a phenyl group, but Applicants submit that R₈ and R₉ of the invention do not correspond with R₄ and R₅ of the cited reference.

The Restriction Requirement also states in paragraph 2 that the application contains claims directed to more than one species of the invention. However, the species are only identified by the statement:

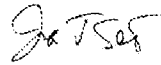
The species are listed in the specification.

As the present specification is 63 pages long, Applicants submit that this requirement is not sufficiently specific to enable Applicants to determine what species might be involved, and to elect such a species.

If the Examiner has intended to make a requirement for an election of species, it is requested that he identify such species with particularity.

Examination on the merits is requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "I. J. Schultz", with a stylized flourish at the end.

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